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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,271

07/25/2003

Earl A. Hubbell

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22886

7590

07/28/2006

AFFYMETRIX, INC

ATTN: CHIEF IP COUNSEL, LEGAL DEPT.

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SANTA CLARA, CA 95051

EXAMINER

WHALEY, PABLO S

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/627,271	Applicant(s) HUBBELL, EARL A.	
	Examiner Pablo Whaley	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Applicant's election without traverse of Species (i), directed to oligonucleotides, in the reply filed on 04/19/2006 is acknowledged. The examiner wishes to acknowledge and thank the applicant for a timely election of this species. After further consideration, however, it has been determined that instant claims 1-40 do in fact recite distinct inventions that have acquired a separate status in the art because of their recognized divergent subject matter. Therefore a further supplementary restriction requirement, listed below, is required. The examiner sincerely apologizes for failing to make this distinction in the previous office action, and for any inconvenience this has caused the applicant.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 1-3 and 22-24 drawn to a computer implemented method and software product for arranging polymers for combinatorial synthesis, classified in class 702, subclass 019. If this Group is elected, then the below summarized specie elections are also required.

Group II: Claims 4-14 and 25-33 drawn to a computer implemented method and software product for arranging polymers for combinatorial synthesis, classified in class 702, subclass 019. If this Group is elected, then the below summarized specie elections are also required.

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Group III: Claims 15-21 and 34-40 drawn to a computer implemented method and software product for arranging polymers for combinatorial synthesis, classified in class 702, subclass 019. If this Group is elected, then the below summarized specie elections are also required.

The inventions are distinct and divergent, each from the other because of the following reasons:

The invention of Groups I, II, and III are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups I, II, and III have different modes of operation. Group I, unlike Groups II or III, recites a traveling salesman optimization. Group II recites steps directed to division of polymers into blocks and edge counts. Group III, unlike Groups I or II, recites steps directed to reducing non-robust probes. Therefore, the burden of search is maintained as the examination process requires a search of non-patent literature, U.S. patent publications, U.S. patents, as well as foreign patent literature.

SPECIE ELECTION REQUIREMENT

This application contains claims directed to patentably distinct species of the claimed invention. If Group I, II, or III is elected, the applicant is further required to make the following specie elections for purposes of examination:

It is acknowledged that applicant has already elected oligonucleotides in the response filed 4/19/06. However, in view of the new restriction requirement set forth above, applicant is given the option of electing a different species, if desired. If no species election is specifically set forth in the response to this restriction requirement, it will be

assumed that "oligonucleotides" are still elected. The examiner again apologizes to applicant for any inconvenience or confusion.

Specie A: Claims 4 and 25 are generic to a plurality of disclosed patentably distinct species of polymers [Specification, p.12 and p. 23] comprising:

- (i) oligonucleotides
- (ii) peptides
- (iii) polysaccharides
- (iv) RNA

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic to the above species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if

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the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Whaley whose telephone number is (571)272-4425. The examiner can normally be reached on 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pablo S. Whaley

Patent Examiner
Art Unit 1631
Office: 571-272-4425

MARJORIE A. MORAN
PRIMARY EXAMINER

Marjorie A. Moran
7/24/06